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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,616	08/10/2001	Eric W. Triplett	960296.97273	5346
7590	02/15/2005		EXAMINER	
David M. Kettner Quarles & Brady LLP 1 South Pinckney Street P O Box 2113 Madison, WI 53701-2113			HELMER, GEORGIA L	
			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 02/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/927,616

Applicant(s)

TRIPLETT ET AL.

Examiner

Georgia L. Helmer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 6-13, 15-22, 24 and 25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

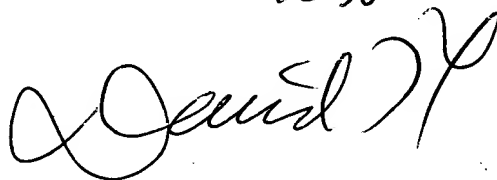
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

1. 11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see the attached Advisory Action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: Notice of References Cited-PTO-892 attached.

Continuation of 3. NOTE: The proposed amendment raises the issue of new matter: the biocontrol agent to be inoculated onto the plant is either "Rhizobiaceae" (claims 1 & 28), or "Rhizobium or Agrobacterium"(claim 10), or "Rhizobium" (claims 26-27) and the biocontrol agent being "sprayed onto the crown of the plant". Also the amendment raises new issues not previously considered: application of art rejection to at least new claims 26-27; application of enablement rejection re plant host to new claims 26-32; application of enablement rejection re means of trifolitoxin production to new claims 28-32 Also a new 112.2 indefiniteness rejection of claim 12 for depending on a canceled claim..

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Advisory Action

1. Receipt of Applicant's After-Final amendment dated 11 November 2004 is acknowledged.
2. Claims 1-4, 6-13, 15-22, 24 and 25 are pending.

Claim Rejections - 35 USC § 112 Enablement

3. Claims 1-4, 6, 13, 15-22 and 24-25, remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has submitted a Rule 1.132 Declaration from Eric Triplett, an inventor of this application. This Declaration presents data that trifolitoxin-producing bacteria are able to prevent crown gall on grapes (Declaration. p. 2). Applicant asserts (Response, p. 6) that since the claims have been limited to plant species that are susceptible to crown gall disease, the scope of the claims are not overly broad. Applicant's traversal is unpersuasive. The claim language "a method for controlling crown gall disease on a plant species susceptible to the disease" is merely a statement of intended use, and not a substantive limitation of the claim. The grape evidence does not provide enablement for the broad scope of any plant species.

Claim Rejections - 35 USC § 102

4. Claims 1, 7, 9, 10, 16, 18, 19 and 25 remain rejected under 35 U.S.C. 102(b) as being anticipated by Robleto, et. al. Environmental Microbiology, 1998, Vol 64, No. 7, page 2630-2633 (Applicant's IDS)

Applicant traverses saying primarily that Robleto et. al. and/or Briel do not suggest use of an α -proteobacteria bearing plasmid pT2TFXK in a method of controlling crown gall in plants, and that even though Robleto et. al. discloses that trifolitoxin production can limit nodulation of trifolitoxin sensitive Rhizobium on bean roots, the disclosure does not teach anyone that trifolitoxin could inhibit crown gall formation of stems of Nicotiana, grape or any other plant species (3 May 2004 Response, p. 8). Applicant's traversal is unpersuasive and not in accord with the scope of the claims. None of the claims other than claims 8 and 17, are drawn to grape, and none of the claims are drawn to a stem.

Applicant traverses saying primarily that the bacterial inoculation procedures for Rhizobium and Agrobacterium are different because the bacteria are different and the root and stem sites are different. Applicant's traversal is unpersuasive and not in accord with the scope of the claims. No claims are drawn to stem inoculation sites, and claims limited to Agrobacterium were not included in the rejection.

Furthermore, the prior art teaches a genetically engineered α -proteobacteria comprising a pT2TFXK plasmid, and so anticipates product claims 19 and 25, since the ability of the identical stain as that claimed to act as a biocontrol agent would have been an inherent property. Additionally, the prior art teaches all the method steps and

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starting materials of process claims 1, 7, 9, 10, 16 and 18, wherein the desired result of crown gall control would be inherent following the trifolitoxin production taught by the prior art.

5. Claims 1, 6, 7, 9, 10, 15, 16, 18, 19 and 24-25 remain rejected under 35 U.S.C. 102(b) as being anticipated by Robleto as applied to claim 1, 7, 9, 10, 16 and 18 above, in light of Breil, et. al., J. Bacteriol. 1993, vol. 175, pages 3696-3702 (Applicant's IDS), and Breil et al, NCBI Accession No. L06719, locus RHMTFXA2G, 4 August 1993.

Applicant traverses saying primarily that Breil only discloses the nucleotide sequence of the trifolitoxin genes, and that with the exception of trifolitoxin, all must be regarded as putative because Breil does not provide any information regarding the function of the genes involved in trifolitoxin production (3 May 2004 Response, p.8). Applicant's traversal is unpersuasive. Breil teach not only the nucleotide sequence for the trifolitoxin genes, but also the amino acid sequence which corresponds to the TfxA peptide backbone of the polypeptide trifolitoxin toxin (Figure 1, legend). Clearly the Tfx operon is both necessary and sufficient to code for this peptide toxin.



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